

Appl. No. 10/706,065
Response E Dated January 17, 2008
Reply to Office Action of July 17, 2007

Docket No. 27600/X014A

REMARKS

Claims 1-55 are pending and at issue in the present application. Claims 1-55 have been rejected as obvious over varying combinations of Dooley U.S. Patent No. 6,257,566, Graushar U.S. Patent No. 5,100,116, or Weller U.S. Patent No. 4,989,850 and Warmus *et al.* U.S. Patent Nos. 6,327,599 and 5,963,968.

Applicants respectfully traverse such rejections of claims 1-55 and have enclosed herewith a declaration by Michael Sittinger under 37 C.F.R. § 1.132 to overcome same.

As discussed in the attached declaration, none of the art cited by the examiner discloses or suggests a book production apparatus including a demand printer operable during the single production sequence to produce different printed pages in response to print commands issued during a single continuous production sequence, wherein the demand printer prints customized content on at least a portion of at least one of the pages without limitation as to position and orientation of the customized content over an entire surface of the at least one page together with a controller that coordinates simultaneous issuance of the print commands to the demand printer and operation of a gathering line, the demand printer, and a feeding device during the single production sequence, as recited by claims 1-22 and 55.

Further, none of the prior art cited by the examiner discloses or suggests a book production apparatus including a demand printer for producing first and second different pages each having customized content that is disposed in an orientation at a position on a surface thereof, wherein the first and second pages are printed during a time interval during which a gathering line is continuously moving and wherein the demand printer includes means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page together with a controller that coordinates operation of the gathering line, the demand printer, a feeding device, and timing of the demand printer during a production sequence to produce customized books, as recited by claims 23-35 and 43-48.

Still further, none of the art cited by the examiner discloses or suggests a method of

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producing books including the step of supplying a demand printer for producing first and second pages wherein at least one of the pages has customized content printed on at least a portion thereof without limitation as to position and orientation of the customized content over an entire surface of the at least one page together with the step of coordinating simultaneous operation of a gathering line, the demand printer, a feeding device, and timing of the demand printer during a production sequence to produce books. These steps are recited by claims 36-42 and 49-54.

It would not have been obvious to include the electronic press disclosed in the '599 or '968 patent in the systems of Dooley, Graushar, or Weller. In particular, the controllers of Dooley, Graushar, and Weller are programmed to control a printer that prints in a particular position and orientation, wherein the position and orientation can only be changed by shutting down the systems thereof. The controllers of Dooley, Graushar, or Weller would not be capable of coordinating a press such as that of the '599 or '968 patent that can print in different positions and orientations with the systems of Dooley, Graushar, and Weller because there is no disclosure or suggestion in Dooley, Graushar, and Weller as to how the controllers disclosed therein could communicate with the press of the '599 or '968 patent. Further, the controller of the '599 or '968 patent is only programmed to control the demand printer thereof and not a gathering line and/or feeding devices. The substitution of the demand printer and controller of the '599 or '968 patent for the printer of Dooley, Graushar, or Weller would not be trivial. In particular, the controller of the '599 or '968 patent would not be able to synchronize the demand printer with the gathering line and/or feeding devices.

In an obviousness inquiry, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). The motivation to combine prior art to solve a problem may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *Dyster Textilefarben GMBH v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006). The Supreme Court has held that the teaching, suggestion, motivation ("TSM") test should not be strictly applied. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007). However, the Court also noted that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the

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prior art." *Id.* Instead, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." The examiner has not stated any reasons why a person of ordinary skill in the art would have been prompted to combine any of the cited art to arrive at the subject matter recited by claims 1-55.

Furthermore, at least a reasonable expectation of success in combining prior art references is required to render an invention obvious. *In re Merck & Co.*, 800 F.2d 1091, 1096 (Fed. Cir. 1986). There is no suggestion that a combination of any of Graushar, Dooley, or Weller with the '599 or '968 patents would have successfully resulted the subject matter recited by claims 1-55. Therefore, it follows that the claimed subject matter is not rendered obvious by the cited art.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested.

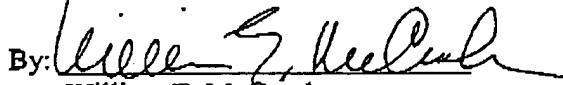
An early and favorable action on the merits is respectfully requested.

Deposit Account Authorization

The Commissioner is hereby authorized to charge any deficiency in any amount enclosed or any additional fees which may be required during the pendency of this application under 37 CFR 1.16 or 1.17, except issue fees, to Deposit Account No. 50-1903.

Respectfully submitted,

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